

REMARKS

Status of the Claims

The Office Action dated June 22, 2010 has been received and reviewed by the applicant. Claims 12-28 are pending in the application. Claims 12-28 stand rejected. Reconsideration is respectfully requested.

Claims 12-18 stand rejected under 35 U.S.C. 12, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 and its dependent claims 13-15 stand rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. Claim 13 and its dependent claim 14 stand rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Claim 14 stands rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP §2172.01. Claim 16 and its dependent claims 17-18 stand rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

This rejection is traversed in its entirety as not comporting with the clear guidelines of MPEP §2172.01. This section states:

A claim which omits matter disclosed to be essential to the invention "as described in the specification or in other statements of record" may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

In addition, a claim which fails to interrelate essential elements of the invention "as defined by applicant(s) in the specification" may be rejected under 35 U.S.C. 112, second

paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965) (“[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result”); *Ex parte Huber*, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes).

This section clearly sets two conditions on which this section may be relied. The first sentence of the first paragraph states that essential subject matter is that which “the specification” defines as essential. Clearly, the specification has not defined the elements on which the rejection relies as essential. This is an applicant-based standard (since the applicant defines what is essential, not the USPTO) and the rejection does not state where these elements are described as essential. The rejection does not meet this standard. The first sentence of the second paragraph states that essential elements are those “defined by applicant(s) in the specification.” Again, the rejection does not state where any of the elements on which the rejection relies are defined as essential. It is noted that this is also an applicant-based standard which the applicants defines as essential, not the USPTO. Applicants respectfully submit that they have not defined any of the features the rejection lists as essential and consequently the rejection should be withdrawn.

Claims 12-14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,550,762 (Stoll) (hereinafter “Stoll”). The rejection states that “... (b) a first switch (14a) for directing the print media through a first exit (*exit to the right of element 14A*) or for permitting the print media to continue on the transport path (including 13, 15A and 17); wherein when the printer is in duplex-printing mode and a paper jam is detected (via sensor 101A), the first switch (14A) transports the print media in which duplex-printing is complete out of the first exit (i.e., *exit located to the right of element 14A*) and

the print media in which only one side of the print media has been printed continues through the transport path (including 13, 15A and 17); (c) a flap (18A) for transporting the print media through a second exit (19A) or permitting the print media to continue on the transport path (including 13, 15A and 17A); wherein when the printer is in duplex-printing mode and a paper jam is detected (via 101A), the flap (18A) passes the print media in which only one side of the print media has been printed out of the second exit (19A).”

In response, claims 12 and 16 are amended to more clearly define the invention. More specifically, claim 1 is amended to state that both the first and second exits direct the paper out of the transport path, which is necessary for clearing paper jams.


In contrast, in Stoll, the elements on which the rejection relies as exits are “within” the paper path. More specifically, the rejection states that the exit located to the right of element 14A of Stoll is analogous to the first exit of claim 1, which element 14A is still within the paper path. The rejection states that the paper path 19A is analogous to the second exit, which path 19A is a part of the paper path (see Figs. 1 and 3 of Stoll). The claimed invention includes the advantage of clearing the paper path so that paper jams can be quickly eliminated. Stoll does not have this advantage.

In summary, claim 1 includes features and advantages of which Stoll are clearly and unambiguously devoid. Claim 16 includes substantially the same limitations as claim 12 and is patentable for the same reasons as claim 12. Each dependent claim is patentable for the same reason as their respective dependent claim.

In light of the above, the Examiner is respectfully requested to withdraw the outstanding rejection and to pass the subject application to Allowance.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

Respectfully submitted,


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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.